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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,818	12/05/2003	Christopher Tzann-en Szeto	YHOOP009	8561

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EXAMINER

BAROT, BHARAT

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,818

Applicant(s)

SZETO ET AL.

Examiner

Bharat N Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

2. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims second 13 to 17 have been renumbered as 14 to 18.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Summers (U.S. Patent No. 6,816,884). Summers' patent meets all the limitations for claims 1-18 recited in the claimed invention.

6. As to claim 1, Summers teaches a method for sharing a wish list (column 13 lines 11-15), comprising: displaying and modifying the wish list (figure 11; and column 10 lines 34-53); and sending substantially in real-time information associated with the wish list (figures 3-4; and column 12 line 65 to column 13 line 26).

7. As to claim 2, Summers teaches that the wish list is modified and sent by an instant messaging application (column 9 lines 36-53).

8. As to claim 3, Summers teaches that the wish list is stored locally on a device associated with an owner of the wish list (figures 1-2; column 6 lines 26-48; column 9 lines 54-65; and column 10 line 54 to column 11 line 8).

9. As to claim 4, Summers teaches that the information is sent from a first device associated with a first instant messaging application instance to a second device associated with a second instant messaging application instance (column 9 lines 36-53).

10. As to claims 5-8, Summers teaches that modifying the wish list includes performing a search on a database or Internet and adding a search result to the wish list (figures 3-4 and 11; column 10 lines 34-53; and column 12 line 65 to column 14 line 17).

11. As to claim 9, Summers teaches that sending a notification indicating that the wish list has been changed (column 7 line 43 to column 8 line 7).

12. As to claims 10-12, Summers teaches that the wish list information includes a compressed representation of the wish list (column 13 lines 36-49) and also includes a search phrase and further comprising performing a search using the search phrase on a device receiving the wish list information (column 13 line 50 to column 14 line 17).

13. As to claim 13, Summers teaches that the wish list is integrated with an e-commerce website (column 5 lines 19-25; and column 12 line 65 to column 13 line 10).

14. As to claim 14, Summers teaches that the wish list is sent via a broadcast protocol (column 5 lines 26-36; and column 7 lines 3-28).

15. As to claim 15, Summers teaches that the wish list is selected from a plurality of wish lists created for a plurality of user categories (figure 1; and column 4 line 37 to column 5 line 26).

16. As to claim 16, Summers teaches a method for exchanging a wish list (column 13 lines 11-15), comprising: modifying a wish list on a first device; sending the wish list from the first device to a second device; and displaying the wish list on the second device, wherein the first device is substantially a real-time communication device (figures 3-4 and 11; column 10 lines 34-53; and column 12 line 65 to column 13 line 26).

17. As to claims 17-18, they are also rejected for the same reasons set forth to rejecting claim 1 above, since claim 17 is merely an apparatus and claim 18 is merely a computer program product having the instructions for the method of operation defined in the claim 1.

Additional References

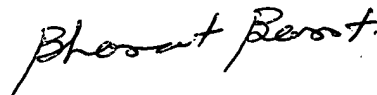
18. The examiner as of general interest cites the following references.
- a. Rothschild, U.S. Patent No. 6,651,053.
 - b. Lee et al, U.S. Patent No. 6,611,814.
 - c. Cusack et al, U.S. Patent No. 6,493,724.

Contact Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bharat Barot whose telephone number is (571) 272-3979. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alam, Hosain, can be reached at (571) 272-3978.

Any inquiry of general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-3900.



**BHARAT BAROT
PRIMARY EXAMINER**

Patent Examiner Bharat Barot

Art Unit 2155

March 03, 2005